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EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/348,693

Applicant(s)

VAN ET TEN ET AL.

Examiner

Naeem Haq

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicants' amendment D, paper number 17, filed on December 10, 2003. Claims 1-26 are pending and will be considered for examination.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 1, this claim recites the limitation "updated information, wherein said updated information is obtained in part from said special requisition and added to said database for future reference." It is unclear to the Examiner how this update information is related to the elements of the system claim. In addition claims 1 and 5 also recite the limitation "...in part..." It is unclear to what extent the updated information is obtained from the special requisition.

Referring to claims 2-19, these claims recite the terms "predetermined relationships", and/or "predetermined rules". It is unclear the Examiner what these term mean or what affect they have on the structural elements of the system. The

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specification does not provide a definition for these terms, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For examination purposes, the Examiner will assume that these terms refer to a set of criteria for maintaining and updating a database. Additionally, claim 6 recites the limitation "...said at least one supplier is a plurality of suppliers..." However, claim 1 recites the limitation "...at least one supplier..." Therefore, the scope of claim 6 is unclear to the Examiner since the metes and bounds of claim 1 can be satisfied with only one supplier while claim 6 requires more than one supplier.

***Claim Rejections - 35 USC § 101***

Claims 17-22 and 24-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicants' invention is directed to a method for purchasing an item. However, the claim language does not explicitly recite any technology in the body of the claims language. Ex parte Bowman requires non-trivial recitation of technology in the body of the claim language. In the present case, claims 17-22 and 24-26 do not recite any technology in the body of the claims. In amendment C, paper number 15, the Applicants argued that both the specification and claims recite hardware and software limitations. The Examiner respectfully disagrees. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore any technology recited in the specification but not explicitly recited in the claim language is not read into the claims. The

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Applicants also argued that claims 17 and 20 recite the limitations “normalized”, “database”, and “knowledge base” and that these terms render the claimed invention statutory because these terms require technology. The Examiner disagrees. As noted above in the 112, 2<sup>nd</sup> paragraph rejection, the terms “normalized” and “knowledge base” are not defined by the specification. Therefore it is unclear whether these terms invoke any technology. Likewise a “database” can be a filing cabinet containing paper files and does not inherently require the use of any technology. For these reasons, claims 17-22 and 24-26 are deemed to be not within the technological arts. *The claimed invention must utilize technology in a non-trivial manner (Ex parte Bowman, 61 USPQ2d, 1665,1671 (Bd. Pat. App. & Inter. 2001))*. Although Bowman is not precedential, it has been cited for its analysis.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner et al (US Patent 5,758,327).**

Referring to claim 1, Gardner teaches a procurement system for purchasing a special item between a buyer of the special item and at least one supplier capable of supplying the special item, said system comprising:

- a fulfillment system for communicating between said buyer and the supplier (Abstract, column 4, lines 7-12, lines 45-66);

- a database associated with said fulfillment system, said special item not being located within said database (column 2, line 51 – column 3, line 3);
- a special requisition for describing said special item (column 2, line 66 – column 3, line 3; column 7, lines 19-23; column 9, lines 14-18).

Gardner does not explicitly teach updated information, wherein said updated information is obtained in part from said special requisition and added to said database for future reference. However, Gardner teaches that a non-catalog requisition requires a purchasing agent to locate and negotiate a price with a vendor (column 9, lines 14-18). Furthermore, Gardner teaches that his system facilitates the purchase of products and services in an *automated* fashion, and that once an item is pre-approved and pre-negotiated it can be directly communicated to the appropriate vendor to fill the order (column 5, lines 29-42). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to update the database of Gardner with the information from the non-catalog requisition. Gardner provides the motivation for this by stating "The goal is to handle the majority of customer transactions via the catalog model, thereby capitalizing on *previously negotiated contracts and eliminating non-value-added activities.*" (emphasis added) (column 5, lines 39-42). Clearly, Gardner wants to prevent a purchasing agent from re-negotiating a price with a vendor every time a requisition for a particular non-catalog item is submitted. Once a price has been negotiated, Gardner wants his system to capture this information and to eliminate all non-value-added activities.

**Claims 2, 3, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner et al (US Patent 5,758,327) in view of Korth et al. "Database System Concepts" and further in view of Povilus (US Patent 5,740,425).**

Referring to claim 2, as noted above in the 112, 2<sup>nd</sup> paragraph rejection, the terms "predetermined relationships", and/or "predetermined rules" are indefinite. Therefore the analysis of these claims will be as per the assumptions given in the 112, 2<sup>nd</sup> paragraph rejection. Gardner does not teach a knowledge base comprising a plurality predetermined relationships and a plurality predetermined rules, and that the catalog item information is normalized with respect to predetermined relationships in accordance with predetermined rules. However, Gardner teaches a system comprising a plurality of predetermined rules and a catalog in a central system (column 2, lines 51-66; column 4, line 45 - column 5, line 29). Gardner does not teach that the catalog is normalized with respect to a plurality of predetermined relationships in accordance with predetermined rules. However, Korth teaches a system for normalizing a relational database with respect to predetermined relationships and predetermined rules (pages 173-209). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Korth into the system of Gardner. One of ordinary skill in the art would have been motivated to do so in order to eliminate unnecessary redundancy in the database. Neither Gardner nor Korth teach a knowledge base. However, Povilus teaches a knowledge base for an electronic catalog (column 3, lines 20-24; column 13, lines 25-35; column 14, lines 25-39; column 17, lines

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33-44). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Povilus into the system of Gardner. One of ordinary skill in the art would have been motivated to do so in order to provide a user with hierarchy of products which the user could navigate through various paths, as taught by Povilus (column 9, lines 53-64).

Referring to claim 3, Gardner and Korth do not teach that the special requisition is partially normalized according to said predetermined rules, with said buyer suggesting enhancements to said predetermined relationships for creating a potential unique description of the special item. However, Povilus teaches an electronic catalog which allows a customer to combine multiple normalized SKUs to configure a special custom product with enhanced form or functionality that will be designated by a new normalized SKU (column 22, lines 40-53) which constitutes a unique description of the special item. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Povilus into the system of Gardner and Korth. One of ordinary skill in the art would have been motivated to do so in order to allow a customer to have greater control of the contents of the catalog used in the system of Gardner.

Referring to claim 8, Povilus discloses a system where the updated special item information is normalized according to predetermined rules and stored within the catalog database (col. 21, lines 32-34 and col. 22, lines 10-19). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Povilus into the



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system of Gardner and Korth. One of ordinary skill in the art would have been motivated to do so in order to automate future orders as taught by Gardner.

Referring to claim 9, Povilus teaches an electronic catalog which comprises predetermined relationships including class (col. 13, line 52 - col. 14, line 12), attribute (col. 14, lines 13-18) and value characteristics (col. 15 lines 23-32). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Povilus into the system of Gardner Korth. One of ordinary skill in the art would have been motivated to do so in order to provide a user with hierarchy of products which the user could navigate through various paths, as taught by Povilus (column 9, lines 53-64).

**Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner et al (US Patent 5,758,327) in view of Chen et al. (US Patent 6,507,856 B1)**

Referring to claim 20, Gardner teaches a procurement method for ordering a special item comprising the steps of:

- searching for an item within a database (column 2, line 51 – column 3, line 3; column 5, lines 3-65);
- determining that said item is not within said database (column 2, line 51 – column 3, line 3);
- when it is determined that said item is not within said database performing the steps of:
  - a) creating a requisition for said item (column 2, line 66 – column 3, line 3);

b) transmitting said requisition to at least one potential supplier  
(column 9, lines 3-25);

c) locating a desired supplier for said item (column 9, lines 3-25);

Gardner does not teach that the requisition is a structured requisition. However, Chen teaches a structured requisition used for a procurement process (Figure 1, column 4, lines 55-67). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Chen into the method of Gardner. Chen provides the motivation for doing so. Chen teaches that typical transactions between business partners involve paperwork and delays. Furthermore, Chen teaches that maintaining a document pair (e.g. purchase order/invoice) is tedious (column 1, lines 13-32). Therefore one of ordinary skill in the art would have been motivated to do so in order to dynamically exchange documents while eliminating delays. Gardner does not explicitly teach adding said item to said database. However, Gardner teaches that a non-catalog requisition requires a purchasing agent to locate and negotiate a price with a vendor (column 9, lines 14-18). Furthermore, Gardner teaches that his system facilitates the purchase of products and services in an *automated* fashion, and that once an item is pre-approved and pre-negotiated it can be directly communicated to the appropriate vendor to fill the order (column 5, lines 29-42). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to add the non-catalog item to the database of Gardner. Gardner provides the motivation for this by stating "The goal is to handle the majority of customer transactions via the catalog model, thereby capitalizing on *previously negotiated*

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*contracts and eliminating non-value-added activities.*" (emphasis added) (column 5, lines 39-42). Clearly, one of ordinary skill in the art would realize that Gardner's invention eliminates non-value-added-activities by automating the purchase order.

Once a price has been negotiated, Gardner's invention captures this information so that a purchasing agent does not have to re-negotiate with a supplier every time an order is placed.

**Claim 10-16 and 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Povilus (US Patent 5,740,425) in view of Dudle et al. (US Patent 5,570,291).**

Referring to claim 10, Povilus teaches a normalized catalog database comprising at least one unique catalog item, wherein each unique catalog item stored within said catalog database is identified with respect to class, attribute and value relationships (col. 3, lines 10-13; col. 6, lines 33-65; col. 9, line 53 – col. 10, line 63; col. 17, lines 42-46), a knowledge base comprising a set of predetermined rules for converting free form catalog information into the normalized catalog database (col. 14, lines 25-33 and col. 19, lines 64-67), and an item selection procedure for locating a desired item within the catalog database (col. 48, lines 4-36). Povilus does not teach a procurement system for purchasing a desired item. However, the Examiner notes that this limitation is recited only in the preamble of the claim and not in the body. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are

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able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Povilus also does not teach an item specifying procedure that is invoked when the desired item can't be located by said item selection procedure within the catalog database. However, Dudle teaches a system that allow customers to create custom orders for special items in addition to a catalog of off-the-shelf products (col. 8, lines 32-36), which can then be added to the database for processing future orders (col. 10 lines 31-34). It would have been obvious to one having ordinary skill in the art to combine the electronic catalog of Povilus with Dudle's custom product ordering system so as to provide a customer with an item specifying procedure for an item not found in a catalog, thereby increasing customer satisfaction.

Referring to claims 11 and 12, Povilus substantially discloses the invention but does not disclose a procurement system where a structured requisition with a new class, attribute or value added to preexisting relationships to uniquely identify a desired item is automatically sent to suppliers who were identified by the relationships used to create the structured requisition. Dudle et al. disclose a system wherein a structured requisition is created by modifying an existing item specification which is stored in the database (col. 11, lines 57-63), and wherein a supplier for a structured requisition can be identified based on analysis of which supplier is equipped to most efficiently produce the custom item specifications stored in the database (col. 8, lines 14-24), and can be automatically selected by the system in the course of generating a production order (col. 15, lines 41-44 and 52-54). It would have been obvious to one having ordinary skill in

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the art to combine Povilus's method for publishing electronic catalogues with Dudle et al.'s custom product ordering system so that a customer who wishes to place a special order can do so directly from the online catalog system and save time.

Referring to claims 13-16, Povilus substantially discloses the invention, including a new predetermined rule which uniquely identifies a desired item being added to a knowledge base to provide an update to class, attribute and value relationships (col. 41, lines 31-47), storing identifying information concerning the desired item in the database in accordance with predetermined relationships (col. 34, lines 13-36), and a new desired item becoming a catalog item available through the selection procedure (col. 34, lines 28-30 and col. 43, lines 27-30). Povilus does not disclose a system where a structured requisition is used to develop a new predetermined rule for uniquely identifying the desired item. Dudle et al. disclose a system with a rules selection subsystem which allows users to add rules as guidelines for creating a custom matrix for a specific customer and storing the rules in the database for future reference (col. 18, lines 4-15). It would have been obvious to one having ordinary skill in the art to combine Povilus's method for publishing electronic catalogues with Dudle et al.'s custom product ordering system so that a manufacturer of a custom item can make its catalog customers aware that the new product exists for the purpose of increasing sales.

Referring to claim 20, Povilus teaches searching for an item within a database (col. 8 lines 2-14 and col. 10 lines 27-60), determining that the item is not in the database (col. 11 lines 4-58), when it is determined that said item is not within said

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database performing the steps of: locating a desired supplier for an item (col. 12, lines 16-19), and adding a new item to the catalog database (col. 36 lines 31-39). Povilus does not teach a procurement method. However, the Examiner notes that this limitation is recited only in the preamble of the claim and not in the body. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Povilus also does not teach creating a structured requisition for an item not within a database. Dudle teaches creating a structured requisition for a special or custom item not found in a database (see discussion of claims 1, 10 and 17 above), and transmitting the custom order to a potential supplier (col. 3 line 59 - col. 4 line 6). It would have been obvious to one having ordinary skill in the art to combine Povilus's method for publishing electronic catalogs with Dudle et al.'s custom product ordering system so that a special item can be quickly produced for a customer and added to a catalog database for ease of ordering future copies of the item, thereby increasing customer satisfaction.

Referring to claim 21, Povilus teaches normalizing the catalog database by categorizing a new item in accordance with class, attribute and value relationships (col. 9, lines 26-52).

Referring to claim 22, Povilus teaches a system where the step of creating a structured requisition for an item includes the step of identifying normalized relationships for the item (col. 12, lines 5-13).

Referring to claim 23, Povilus teaches a system where the transmitting step includes the step of automatically identifying a potential supplier using normalized relationships (col. 12, lines 16-19 and lines 48-52).

Referring to claim 24, Povilus teaches a system where the step of locating a desired supplier for an item includes the step of creating a new relationship uniquely identifying the item by updating normalized relationships (col. 37, lines 15-33).

Referring to claim 25, Povilus teaches a system which uses a new relationship to add a new item to the database (col. 34, lines 22-36).

Referring to claim 26 Povilus teaches a system including a knowledge base and free form data (col. 30, lines 1-6), adding a new relationship to the knowledge base (col. 36, lines 18-21), processing free form data through the knowledge base (col. 36, lines 47-51), and updating the database (col. 38, lines 11-41).

**Claim 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Povilus (US Patent 5,740,425) in view of Dudle et al. (US Patent 5,570,291) and further in view of Official Notice.**

Referring to claims 17-19, Povilus teaches a system including establishing a normalized database of catalog items based on predetermined relationships including class, attribute and value characteristics (col. 3, lines 10-13 and col. 17, lines 42-46), determining rules for converting free form information associated with catalog items into

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the normalized database (col. 13, lines 25-28 and col. 19, lines 64-67), specifying an additional relationship (see col. 36, lines 18-40, where a new tuning fork node is created, thus specifying a new index to uniquely identify for a new and unique product not found in a catalog database), including at least one class (col. 13, line 52 - col. 14, line 12), attribute (col. 14, lines 15-18) or value (col. 15 lines 23-32) to uniquely identify a new item, incorporating the new class, attribute or value from the specifying step into the determining rules (col. 34, lines 30), and adding the special item to the database using the updated rules (col. 36 line 6 - col. 37 line 13). Povilus does not teach a procurement system. However, the Examiner notes that this limitation is recited only in the preamble of the claim and not in the body. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Povilus also does not teach processing a request for a special item not located within the catalog database using the predetermined relationships. However, Dudle teaches a customer or sales representative processing a custom order for a business form that is not located in the electronic database, such as creating the form using form design software. Use of such software requires the application of standard rules and procedures that would apply to any custom form being designed (col. 9 line 65 - col. 10 line 34). Therefore, it would have been obvious to one having ordinary skill in the art to combine the electronic



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catalog of Povilus with Dudle et al.'s custom product ordering system so that a custom item can be rapidly added to a catalog using predetermined schema, thereby enabling catalog customers to access a new product for the purpose of increasing sales by selling to a wider market. Dudle does not explicitly teach that the standard rules and procedures correspond to predetermined relationships in a database. However, Official Notice is taken that the use of XML for the interchange of information and to create domain-specific templates within an industry is old and well known. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use XML as part of the standard rules and procedures of Dudle. One of ordinary skill in the art would have been motivated to do so in order to use a simple, robust, and human-readable method for describing any content.

**Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Povilus (US Patent 5,740,425) in view of Gardner et al (US Patent 5,758,327).**

Referring to claim 10, Povilus teaches a normalized catalog database comprising at least one unique catalog item, wherein each unique catalog item stored within said catalog database is identified with respect to class, attribute and value relationships (col. 3, lines 10-13; col. 6, lines 33-65; col. 9, line 53 – col. 10, line 63; col. 17, lines 42-46), a knowledge base comprising a set of predetermined rules for converting free form catalog information into the normalized catalog database (col. 14, lines 25-33 and col. 19, lines 64-67), and an item selection procedure for locating a desired item within the catalog database (col. 48, lines 4-36). Povilus does not teach a procurement system for purchasing a desired item. However, the Examiner notes that this limitation is recited

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only in the preamble of the claim and not in the body. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Povilus also does not teach an item specifying procedure that is invoked when the desired item can't be located by said item selection procedure within the catalog database. However Gardner teaches a procurement system for purchasing a desire item (Abstract; column 1, lines 5-8; column 4, lines 45-66). Furthermore, Gardner teaches an item specifying procedure that is invoked when the desired item can't be located by said item selection procedure within the catalog database (column 9, lines 14-18). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Gardner into the system of Povilus. Povilus provides a motivation for do so by stating that his catalog is intended to be used by a variety of individuals including people who place an order for a product (column 1, lines 38-67).

**Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner et al (US Patent 5,758,327) in view of Povilus (US Patent 5,740,425) and further in view of Dudle et al.**

Referring to claims 4 and 5, Gardner and Povilus substantially disclose the invention, including adding a new predetermined rule to uniquely identify a special item (col. 34, lines 13-36 and col. 36, lines 18-39), and a fulfillment organization

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normalizing the updated data received from the supplier (col.34, lines 22-30) based on identical classes and attributes (col. 36, lines 18-22 and lines 34-40). Gardner and Povilus does not specifically teach a special requisition including a proposed modification to a predetermined relationship, a supplier reviewing the special requisition, basing the new predetermined rule on updated information within a special requisition, or a buyer comparing the updated information as a basis for comparison between each special item available for purchase. However, Dudle et al. teaches a product estimating and order processing system in which custom item specifications are stored for use as a template for designing further custom business forms (col. 10. lines 27-34), and which allows for a supplier to review a custom product order and make changes as needed (col. 14, lines 47-67). Therefore it would have been obvious to one having ordinary skill in the art to combine Gardner and Povilus's system for updating an electronic catalog to reflect a new product offering with Dudle et al.'s custom order processing system in order to allow a manufacturer to quickly add a new item produced for a special requisition to its online catalog in order to sell to the general public instead of selling only to the buyer who requested the product initially, thereby generating increased revenue into the future.

**Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner et al (US Patent 5,758,327) in view of Povilus (US Patent 5,740,425) and further in view of Dudle et al., and Conklin et al. (US Patent No. 6,338,050).**

Referring to claim 6, Gardner, Povilus, and Dudle not teach a system where a plurality of suppliers review a special requisition and forward updated information for

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comparision by the buyer. Conklin et al. disclose a multivariate negotiations engine which allows a buyer to submit a Request for Proposal or Request for Quote to multiple sellers (col. 20, lines 2330) (col. 6, lines 19-20 and 25-32). It would have been obvious to one having ordinary skill in the art to combine Conklin et al.'s multivariate negotiations engine with Povilus's method for updating an electronic catalog and Dudle et al.'s custom order processing system in order to allow multiple manufacturers to respond to a special requisition placed by a buyer and compete with each other on an equal footing in order to potentially increase each manufacturer's sales.

**Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner et al (US Patent 5,758,327) in view of Povilus (US Patent 5,740,425) and further in view of Conklin et al. (US Patent No. 6,338,050).**

Referring to claim 7, Gardner, and Povilus teach all the limitations of claim 2 as noted above. In addition, Povilus teaches a system wherein suppliers are identified with specific predetermined relationships (col. 17, lines 49-54). Gardner and Povilus do not teach a fulfillment organization selecting a plurality of suppliers to receive and review a special requisition. However, Conklin discloses a negotiations system which comprises a sponsor who creates and administers a negotiation engine for participation between buyers and sellers (col. 14, lines 1-19), including setting rules for supplier participation to determine that a supplier can fulfill a buyer's requirements (col. 28, lines 46-51). Therefore it would have been obvious to one having ordinary skill in the art to combine the teachings of Conklin with the system of Gardner and Povilus. One of ordinary skill

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in the art would have been motivated to do so in order to create a commercial community with a set of rules administered impartially for buyers and sellers by an administrator.

### ***Response to Arguments***

Regarding the rejection of claim 1, the Applicants are correct that Povilus was not used in the body of the rejection. The heading of the rejection in the last Office Action shows that claim 1 was rejected over Gardner in view of Povilus. This was a typographical error by the Examiner and it has been corrected.

Applicants' arguments with respect to claim 1 have been fully considered but they are not persuasive. The Applicants have argued that Gardner does not teach updating a catalog based on information obtained from a requisition for a non-catalog item. The Applicants contend that Gardner teaches away from adding information for non-catalog items since Gardner allegedly stores information only on pre-approved items and not on approved non-catalog items. The Examiner notes that this distinction between pre-approved and approved items is completely irrelevant since there is nothing the claim language which recites that the special item is either a pre-approved item or an approved item. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants' arguments with respect to claims 2 and 9 have been fully considered. The Applicants have argued that Gardner does not provide a teaching of entering

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content into a catalog based on rules, and that the only rules Gardner refers to are requisition rules for authorization. This argument is moot in view of the new grounds of rejection. The Applicants have also argued that there is no motivation to combine Povilus with Gardner. The Examiner disagrees. Gardner is directed to a requisition system that has an electronic catalog for presenting product information. Povilus is also directed to a system for presenting product information using an electronic catalog. Therefore, the nexus between the two references is an electronic catalog that presents product information to a user. The Examiner has already provided a proper motivation to combine and therefore maintains the combination. Finally, the Applicants have argued that Gardner teaches away from the disclosure of Polivus (see amendment D, page 10, lines 15-20). The Examiner disagrees. Gardner explicitly states "In the preferred embodiment, the step 38 of storing a catalog includes forming a single catalog that includes products and services of all vendors..." (column 5, lines 44-46). For these reasons, the Examiner maintains the art rejection.

Applicants' arguments with respect to claim 3 have been fully considered and are moot in part and are not persuasive in part. The Applicants have argued that Gardner does not provided a buyer with any control over the structure and content of the catalog and that therefore there is no motivation to combine Gardner with Povilus. Furthermore, the Applicants allege that the Examiner has relied on hindsight reconstruction in the rejection of claim 3. The Examiner disagrees. It is true that Gardner provides very little detail about the structure and content of his electronic catalog. Nevertheless, the important point is that Gardner has an electronic catalog that contains product

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information. Povilus also discloses an electronic catalog that contains product information, and Povilus provides ample detail about the structure and content of his electronic catalog. Therefore both references have an electronic catalog that presents product information to a user. Merely replacing one catalog with another catalog is well within the level of one of ordinary skill in the art and does not constitute hindsight reconstruction.

Applicants' arguments with respect to claim 8 have been fully considered and are not persuasive. The Applicants have argued Gardner does not teach automating future orders or incorporating non-catalog items into the catalog database. The Examiner disagrees. Gardner explicitly teaches, "The goal is to handle the majority of customer transactions via the catalog model, thereby capitalizing on *previously negotiated contracts and eliminating non-value-added activities*." (emphasis added) (column 5, lines 39-42). One of ordinary skill in the art would recognize that having a purchasing agent repeatedly contact and negotiate with a supplier every time an order for an item was placed is a "non-value-added activity". To support this point, the Examiner cites the reference Stundza "Coppermetals distribution roundtable." Stundaz teaches that the typical cost of handling a purchase order manually varies from \$35 to \$50 per purchase order. Clearly, one of ordinary skill in the art would realize that Gardner's invention eliminates these non-value-added-activities by automating the purchase order. For this reason the Examiner maintains the art rejection.

Applicants' arguments with respect to claim 20 have been considered but are moot in part in view of the new ground(s) of rejection.

Applicants' arguments with respect to claim 4-7 and 10-26 have been fully considered and are not persuasive. In response to Applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the present case, the Applicants have argued that Dudle is not relevant art because it fails to teach the limitations already taught by the primary reference. This is a piecemeal analysis and is improper. Referring to the Examiner's rejection of claims 10, 17, and 20, the Applicants have argued that Dudle does not teach an item specifying procedure that is invoked when the desired item cannot be located in a catalog database. The Examiner respectfully disagrees. The Applicants support their argument by asserting that Dudle only teaches customizing features of known products with a pre-determined list of specifiable options and only within pre-determined ranges, and that Dudle does not teach that custom products are included in the catalog (pages 17-19). The Examiner would like to point out that the Applicants' claim language does not explicitly exclude products with pre-determined list of specifiable options within pre-determined ranges. The claim language merely recites a catalog database containing an item stored according to some schema; a knowledge database with predetermined rules; an item selection procedure; and an item specifying procedure when a desired item cannot be located in the database. Therefore, the Applicants' argument that Dudle only teaches customizing features of known products with a pre-determined list of specifiable options and only within pre-determined ranges



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is irrelevant with respect to the invention of claim 10. The Applicants appear to be incorporating limitations of the specification into the claim language. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Likewise, the Applicants' argument that Dudle does not teach incorporating custom products into the catalog database also seems to be incorporating limitations from the specification since the claim language never mentions anything about this limitation into the body of the claim. For these reasons, the Examiner maintains the art rejection. In addition, Povilus refers to ordering a product (column 1, lines 50-54).

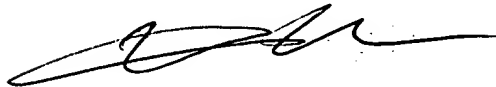
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

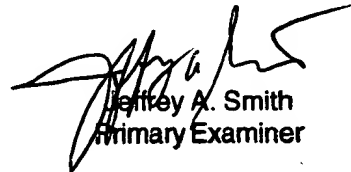
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**Naeem Haq**, Patent Examiner  
Art Unit 3625

March 5, 2004



Jeffrey A. Smith  
Primary Examiner